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Section II. REMARKS

The pending claims under consideration in the application are claims 1-12, 14, 16-47, 49-63, 65, 67-98 and 100-115.

Election/Restrictions

Applicants acknowledge the Examiner's withdrawal of the September 29, 2004 Restriction Requirement.

Allowable Subject Matter

In the December 21, 2004 Office Action, claims 103-107 were allowed and claims 7-51 and 58-102 were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants acknowledge such indication of contingent allowability of claims 7-51 and 58-102, and respectfully request reconsideration of all pending claims 1-14, 16-47, 49-65, 67-98 and 100-115.

Rejection of Claims on Reference Grounds, and Traversal Thereof

In the December 21, 2004 Office Action:

claims 5-6 and 56-57 were rejected under 35 U.S.C. §112, second paragraph;

claims 1-4 and 52-55 were rejected under 35 U.S.C. §102(e) as being anticipated by Carbonell et al. (U.S. Patent No. 6,652,920);

claim 108 was rejected under 35 U.S.C. §102(b) as being anticipated by Yadav et al. (U.S. Patent No. 5,952,040).

These rejections are traversed in application to the claims as amended herein. The patentable

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distinction of the amended claims over the cited references is set out in the ensuing discussion.

Rejection under 35 U.S.C. §112, second paragraph

In the December 21, 2004 Office Action, claims 5-6 and 56-57 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Examiner indicated that the terms "said supercritical fluid" and "said precursor" have insufficient antecedent basis. Applicants vigorously disagree.

Claim 1, upon which claims 5 and 6 directly depend, recites:

"A deposition composition for depositing material on a substrate, said deposition composition comprising a supercritical fluid and a precursor of the material to be deposited on the substrate, wherein said precursor includes a metal atom." (emphasis added)

Clearly, the term "supercritical fluid" in claim 1 is preceded by the indefinite article ("a"), thereby providing proper antecedent basis to the term "said supercritical fluid" in claims 5 and 6. Analogously, the term "precursor" in claim 1 is preceded by the indefinite article ("a"), thereby providing proper antecedent basis to the term "said precursor" in claims 5 and 6.

Claims 56 and 57 correspondingly depend directly from claim 52, which corresponds to claim 1.

Claims 5-6 and 56-57 therefore meet the requirements for clarity and precision under 35 U.S.C. §112 criteria. Withdrawal of this rejection is respectfully requested.

Rejection under 35 U.S.C. §102(e)

In the December 21, 2004 Office Action, claims 1-4 and 52-55 were rejected under 35 U.S.C. §102(e) as being anticipated by Carbonell et al. (U.S. Patent No. 6,652,920) (hereinafter Carbonell). Applicants traverse such rejection.

Applicants have amended claim 1 to recite:

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"A deposition composition for depositing material on a substrate, said deposition composition comprising a supercritical fluid and a precursor of the material to be deposited on the substrate, wherein said precursor includes a metal atom." (emphasis showing amendment)

Claim 52 has been correspondingly amended.

Carbonell relates to a meniscus coating process to coat a surface portion of a substrate with a polymer. Polymers contemplated include a polyurethane, a sol-gel precursor, a polyimide, an epoxy, a polyester, a polyurethane, a polycarbonate, a polyamide, a polyolefin, a polystyrene, acrylic latex epoxy resins, novolac resins, resole resins, polyurea, polyurea urethanes, polysaccharides, etc. (see Carbonell, col. 3, lines 43-50).

Carbonell does not teach or suggest a deposition composition including a metal atom-containing precursor, as claimed by applicants in claim 1.

Accordingly, applicants' claim 1 is not in any way anticipated by Carbonell because each and every element as set forth in the claim is not found, either expressly or inherently described, in the Carbonell reference. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).*

The foregoing distinguishing remarks directed to claim 1, and claims 2-4 dependent thereunder, are equally applicable to claim 52, and claims 53-55 dependent thereunder.

Applicants therefore request that the §102(e) rejection of claims 1-4 and 52-55 over Carbonell be withdrawn.

Rejection under 35 U.S.C. §102(b)

In the December 21, 2004 Office Action, claim 108 was rejected under 35 U.S.C. §102(b) as being anticipated by Yadav et al. (U.S. Patent No. 5,952,040) (hereinafter Yadav). Applicants traverse such rejection.

According to the Examiner:

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"Yadav discloses a method of forming electrodes on a semiconductor substrate comprising contacting the substrate with an electrode material precursor in a supercritical fluid, to deposit electrode material on the substrate [col. 6, lines 50-56]."

Applicants vigorously disagree.

Contrary to the Examiner's contentions, Yadav does not teach or disclose the use of supercritical fluids. Instead, Yadav discloses the use of a suspension of nanoscale powders, whereby the suspension medium may be inorganic or organic, but preferably has a low viscosity, high density, and low vapor pressure, and is chemically inert, environmentally benign, and inexpensive (see Yadav, col. 13, lines 59-62). The suspension mediums disclosed in Yadav include: denatured alcohol with 1 wt % polyethylene glycol (Example 1); polyethylene glycol binder and ethanol solvent (Example 2); denatured alcohol (Example 3); and ethanol (Example 4).

It is apparent from the foregoing that Yadav does not expressly or inherently anticipate applicants' claimed invention because Yadav does not in any way teach or disclose an electrode material precursor in a supercritical fluid, as required by applicants' claimed invention.

Applicants therefore respectfully request withdrawal of the §102(b) rejection of claim 108 based on Yadav

Petition for Extension of Time/Fees Payable

Applicants hereby petition for a one (1) month extension of time, extending the deadline for responding to the December 21, 2004 Office Action from March 21, 2005 to April 21, 2005. The fee of \$120.00 specified in 37 CFR §1.17(a)(1) for such one (1) month extension is hereby enclosed.

In addition, six (6) dependent claims have been cancelled, three (3) independent claims have been added, four (4) dependent claims have been added, and four (4) dependent claims have been converted into independent claims herein. Thus, an added claims fee of $((7-6) \times \$50.00) + (3 \times \$200.00) + (4 \times \$200.00) = \$1,450.00$ is due.

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The total fee of \$1,570.00 is authorized to be charged in the attached Credit Card Authorization Form. Authorization is also hereby given to charge any deficiency in applicable fees for this response to Deposit Account No. 08-3284 of Intellectual Property/Technology Law.

CONCLUSION

Based on all of the foregoing, pending claims 1-12, 14, 16-47, 49-63, 65, 67-98 and 100-115 are now in form and condition for allowance. If any issues remain, incident to the formal allowance of the application, the Examiner is requested to contact the undersigned attorneys at (919) 419-9350 to resolve same, so that the patent on this application can be issued at the earliest possible time. The Examiner's thorough review of the application is acknowledged with appreciation.

Respectfully submitted,



Steven J. Hultquist
Reg. No. 28,021
Attorney for Applicants



Tristan Anne Fuierer
Reg. No. 52,926
Attorney for Applicants

INTELLECTUAL PROPERTY/
TECHNOLOGY LAW
P.O. Box 14329
Research Triangle Park, NC 27709
Phone: (919) 419-9350
Fax: (919) 419-9354
Attorney File No.: 2771-537 CIP (7496)